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EXAMINER

NGUYEN, HANH N

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

1 RECORD OF ORAL HEARING

2  
3 UNITED STATES PATENT AND TRADEMARK OFFICE

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5  
6 BEFORE THE BOARD OF PATENT APPEALS  
7 AND INTERFERENCES  
8

9  
10 Ex parte PATRICK VOHLGEMUTH, PHILIPPE R. MANFE, and  
11 FRANCOIS C. CZAJKOWSKI  
12

13  
14 Appeal 2008-2826  
15 Application 10/613,075  
16 Technology Center 2800  
17

18  
19 Oral Hearing Held: August 12, 2008  
20  
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22  
23 Before JOSEPH F. RUGGIERO, SCOTT R. BOALICK, and JOHN A.  
24 JEFFERY, Administrative Patent Judges.  
25

26 ON BEHALF OF THE APPELLANTS:

27  
28 DANIEL A. TANNER, III, ESQUIRE  
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33 The above-entitled matter came on for hearing on Tuesday, August  
34 12, 2008, commencing at 2:07 p.m., at the U.S. Patent and Trademark  
35 Office, 600 Dulany Street, 9th Floor, Alexandria, Virginia, before Victoria  
36 L. Wilson, Notary Public.  
37

1 THE USHER: Calendar Number 18, Appeal Number 2008-2826.

2 Mr. Tanner.

3 MR. TANNER: Good morning, Your Honors.

4 JUDGE RUGGIERO: Would you spell your name for the reporter.

5 MR. TANNER: I'm Daniel Tanner, T-A-N-N-E-R.

6 May it please the board -- I'm here today from the law firm of Oliff &  
7 Berridge to briefly discuss U.S. Paten Application 10/613075 to a structure  
8 for an automotive alternator.

9 As you understand from my papers, we believe that there are a couple  
10 of errors in the November 16, 2005, final rejection. While my remarks this  
11 afternoon will be primarily directed to the patentability of Claim 1 over the  
12 currently applied references under -- in the 102 rejections, it is not our  
13 position that the claims rise and fall together.

14 We believe, however, that discussion regarding several of the  
15 dependent claims is appropriately set forth in our papers.

16 My contentions regarding the 102 rejections are simply these. First,  
17 the position of the office action completely disregards, if you will, the  
18 unique structure that's the subject matter of the pending claims and the -- and  
19 specifically Claim 1 and the way that those features are indicated as working  
20 together.

21 And, secondly, we believe that the position taken by the office action  
22 and specifically as clarified by the answer takes a position in which it sort of  
23 breaks up the claim language into constituent parts and then addresses each  
24 one of those parts by somewhat narrowly applying court precedent to make -  
25 - in order to make the case and in so doing tends to ignore some of the other  
26 precedent that's out there that we believe weighs more in favor of our

1 position.

2 Claim 1 recites, among other features, that the casing includes at least  
3 one air inlet guide -- grid and at least one air outlet grid, both of which are  
4 integrally -- are made integrally with the casing and wherein the casing is  
5 made as a casting. We think that that set of features needs to be taken as a  
6 whole.

7 What the position of the office action does is it sort of breaks that all  
8 up and first attacks the made integrally arguments by asserting, for instance,  
9 In re Hotte.

10 What we -- what we assert that that does is you need to start with the  
11 beginning of the claim language, wherein the casing includes these air inlet  
12 and outlet grids, and then the term "integrally" is in the claim language to,  
13 basically, reinforce the position that this is unitary structure.

14 Now, the examiner in the answer says, well, wait a minute, it doesn't  
15 say monolithic and it doesn't say integral -- or -- I'm sorry -- it doesn't say  
16 unitary and that's your argument.

17 Well, Hotte, as I'm sure the board is well aware, they had a -- they had  
18 a difficulty in that case, in that what the appellant was attempting to argue  
19 was integral had to mean one piece and the court there found out that that  
20 was -- or asserted that that was irreconcilable with the plain language of the  
21 claims, where our position here is that it shouldn't be as simple a matter as it  
22 is made out in the office action and then reiterated in the answer as going,  
23 okay, just because you use the term "integral" in there, we assert that integral  
24 doesn't have to be one piece, and, therefore, the analysis basically stops  
25 there.

26 The Notte reference takes two separate pieces or multiple separate

1 pieces and bolts them together and then we arrive at what is considered by  
2 the office action to be an integral structure.

3 JUDGE JEFFERY: Let me stop you there and just ask you a  
4 question.

5 MR. TANNER: Yes, sir.

6 JUDGE JEFFERY: Would you consider that to be integral, bolting  
7 two pieces together to another piece so that you have a rigid structure,  
8 notwithstanding the rest of the claim language calling for the casting aspect.  
9 That aside, taking two pieces and bolting them to a casing, is that integral?

10 MR. TANNER: Yes, sir, your Honor, that is integral. The difficulty  
11 is that the analysis of the office action and the answer stops there.

12 We would like to -- to just sort of rewind the tape a little bit and go,  
13 "wherein the casing includes," and as we show at pages 12 and 13 of our  
14 disclosure, it includes an integral -- all of these components integrally made  
15 to a specific benefit, that specific benefit being that there is an ease of  
16 manufacture, in that it is made all as one piece, including integrally as a  
17 casting, and that then during maintenance there is no opportunity or no  
18 requirement, for instance, to do more disassembly than simply removing the  
19 casing.

20 That's what the -- that's the specific benefit that the subject matter of  
21 the pending claims is directed to and, therefore, that's why we believe that  
22 these what we will, you know, plainly assert are structural features need to  
23 be taken as a whole.

24 To proceed a little bit farther, then, the -- as I said before, the focus of  
25 the office action and then the answer is on the reference that says, hey,  
26 "integral" doesn't necessarily mean one piece, it can mean these other things,

1 it can mean put together.

2 But what we would like to focus the board's attention on for a moment  
3 are the precedents of both Otto and Hubble that we mention in our brief, in  
4 which, in Otto, for instance, the Court said while it is true that there is no  
5 invention in making into one whole that which was before in the same form  
6 but in detachable parts -- and here's the important language -- "when there is  
7 no further consequence."

8 We assert that there is a further consequence here and, therefore, more  
9 applicable are precedents like Otto because the making of two into one, to  
10 use the language of the Court here, is something more here has been  
11 accomplished than merely slapping those features together.

12 The concern that we have is that -- is that in applying just -- you  
13 know, fairly regimentally applying the precedent of Hotte, that that's where  
14 the analysis stopped. It didn't take into account the synergy of our language  
15 in the claim and it didn't take into account the benefits that come from this  
16 combination of references.

17 We go even then a step farther and what the -- what the office action  
18 then goes -- discusses is with reference to, for instance, In re Thorp, that the  
19 process by which something is made, now focusing on the casting element,  
20 the casing being made of a casting, it -- again, it wholly separates that  
21 portion and then focuses on that in application of both the Nolte and the  
22 Kayane references.

23 And specifically with reference to Kayane, it cites In re Thorp, going,  
24 hey, the process by which a final product is made may not be -- may not  
25 achieve some patentable distinction.

26 Again, here we are concerned that, having broken it up and having

1 addressed each one of these -- you know, the A, B and C individually and  
2 actually just the B and C, that things like the precedents set forth in Garnero  
3 are ignored.

4 And that's why we talk about that in our responsive brief, as well,  
5 because Garnero asserted that while it is generally the rule that some process  
6 -- that the process by which a product is made may not provide some  
7 patentable distinction, it makes a further distinction in the context of  
8 structural features or allegedly structural features.

9 And Thorp and the string of other case law that comes from Thorp is  
10 directed more at chemical compounds and what we may have found in  
11 putting together chemical compounds and, therefore, the process by which  
12 those products made may or may not be patentable depending on where the  
13 Court comes down.

14 But in the case of a structure, like we have here, we believe that at  
15 least some weight has to be lent to the process by which this product is made  
16 when you come with some beneficial result, and in -- in Garnero, they are  
17 specific in saying that, you know, such features are capable of being  
18 considered structural limitations such as press fitted, etched, welded, in the  
19 case where, you know, if by a correct inquiry it appears that those terms  
20 provide, again, some specific benefit which we assert occurs here, then it is  
21 the combination of all of those features that need to be looked at and not just  
22 simply discounted and we believe that that's what has occurred here.

23 So what we are asking the board to do is to -- is to take a look at the  
24 synergy of what our claims recite.

25 I'm not asking for you to import any limitation or any meaning or  
26 anything else to the specific language in the claims but please just focus on

1 the fact that our claims recite "wherein the casing includes at least one air  
2 grid" -- so the casing includes at least one air grid -- air inlet grid and at least  
3 one air outlet grid, both of which are made integrally -- that's reinforcing to  
4 how the casing includes that -- and that "wherein the casing is made as a  
5 casting."

6 That further reinforces the unique integral monolithic unitary  
7 construction, whatever -- whatever you want to assert applies there but we  
8 think that the precedent supports the construction, that construction, because  
9 there is nothing, for instance, in the record that, you know, whether it be in  
10 our specification or in any of the arguments that we have made, that in, for  
11 instance, like, with the application of Hotte, where that definition can't be  
12 reconciled with the intrinsic record.

13 JUDGE RUGGIERO: Is it your position, then, that a casing made by  
14 casting has a different structural characteristic than a casing made by another  
15 kind of technique?

16 MR. TANNER: Yes, your Honor, it is, because, for instance, a cast  
17 casing with all of these features, okay, has different, you know, metallurgic  
18 characteristics and so on and so forth to one, for instance, if we took just a  
19 blank, pressed it out and started machining on it, you are going to end up  
20 with different structural characteristics to that.

21 So our position is that we are -- that specifically with respect to the  
22 references that are cited here, we think that some leaps have been made and  
23 we think that some focus has been put to very specific claim terms that  
24 perhaps shouldn't have been, that in light of our record and the case law  
25 supports a construction whereby you just can't almost discount these terms  
26 as they seem to have been throughout prosecution here.



1 JUDGE RUGGIERO: Have you presented any evidence on the  
2 record that a casing made by casting is different structurally than a casing  
3 made by another kind of process?

4 MR. TANNER: No, your Honor, we have not today.

5 JUDGE RUGGIERO: So you are, basically, relying on attorney's  
6 arguments in your brief, then?

7 MR. TANNER: Yes, your Honor, we are.

8 Subject to any questions, that's the totality of my brief, sir.

9 JUDGE RUGGIERO: All right. That's it. Thank you.

10 MR. TANNER: Thank you very much for your time today. Excuse  
11 me.

12 (Whereupon, the proceedings at 2:18 p.m. were concluded.)